

The opinion in support of the decision being entered today was *not* written for publication in a law journal and is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JOHN HADFIELD, LOUIS K. KLEIN,
G. ERICH HEBERLEIN, JR., JON W. SIMONS, RICH ROBB,
WAYNE H. WIELEBSKI, and KEVIN A. RETLICH

Appeal 2007-0237
Application 09/672,934
Technology Center 3600

Decided: March 30, 2007

Before ANITA PELLMAN GROSS, JENNIFER D. BAHR, and ROBERT E.
NAPPI, *Administrative Patent Judges*.

GROSS, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Hadfield, Klein, Heberlein, Simons, Robb, Wielebski, and Retlich
(Appellants) appeal under 35 U.S.C. § 134 from the Examiner's final

rejection of claims 1 through 11, 20, 22 through 25, 31 through 35, and 37 through 54, which are all of the claims pending in this application.

Appellants' invention relates to a method for selling engineered systems. Claim 1 is illustrative of the claimed invention, and it reads as follows:

1. A method for selling engineered electrical systems, the method comprising the steps of:

generating a database for an electrical system comprising a plurality of programmable devices, the database including device designation data;

soliciting an order for the system;

assembling the system including the plurality of programmable devices; and

configuring memory objects within the devices by downloading at least the device designation data from the database.

The prior art reference of record relied upon by the Examiner in rejecting the appealed claims is:

Skoolicas	US 6,230,403 B1	May 15, 2001
		(effectively filed Nov. 06, 1997)

Claims 1 through 11, 20, 22 through 25, 31¹ through 35, and 37 through 54 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Skoolicas.

We refer to the Examiner's Answer (mailed December 22, 2005) and to Appellants' Brief (filed September 9, 2005) for the respective arguments.

¹ The Examiner's rejection in the Answer includes claims 27 through 30, but claims 27 through 30 were canceled in Amendment A filed February 28, 2003.

SUMMARY OF DECISION

As a consequence of our review, we will affirm the anticipation rejection of claims 1 through 11, 20, 22 through 25, 31 through 35, and 37 through 54.

OPINION

Appellants contend (Br. 9-11, 14, and 15) that Skoolicas fails to disclose downloading data from the database into the programmable components for configuring the memory objects. Appellants contend (Br. 9-11 and 14-16) that Skoolicas instead discloses "provid[ing] programming specifications to an operator for manual entry into a programmable microprocessor." We first note that claim 1 does not require that the designation data be downloaded into the memory objects. Claim 1 merely recites downloading from the database. Further, as to the remaining independent claims, we find nothing in the portion cited by Appellants (i.e., Skoolicas, col. 34, ll. 47-52) that the data must be manually entered into the programmable elements. Skoolicas mentions an operator for building the system (see Skoolicas, col. 34, ll. 42-46), but there is no indication that the operator must manually enter data downloaded from the database into the programmable elements. Skoolicas discloses (Skoolicas, col. 34, ll. 26-35) that the assembly may be manual or automated. Further, Skoolicas states (Skoolicas, col. 35, ll. 17-20) that automated manufacturing of power system sub-assemblies "allows power supply manufacturers to ship custom power supplies within a day or two after the specification is complete."

Thus, a fairer reading of Skoolicas is that the data is downloaded from the database and automatically entered into the programmable elements.

Appellants further contend (Br. 9, 11-13, and 15) that Skoolicas fails to download designation data from the database. Appellants contend (Br. 11) that "a program—designed simply to manage operation of a device—by no means necessarily includes data regarding such devices' designation..., e.g, [sic], its location, its model, its capabilities, and so forth." We find no definition of "designation data" in the specification, and Appellants have pointed to none. Further as discussed *infra*, we find that the claimed "designation data" is non functional descriptive material and as such can not be relied upon to differentiate the invention from the prior art. Nonetheless, in Skoolicas, the downloaded data includes "programming specifications" (see Skoolicas, col. 34, ll. 47-50). We take "programming specifications" to include information as to device capabilities and operational instructions. Therefore, we find that the data downloaded in Skoolicas satisfies the claimed designation data.

Appellants further contend (Br. 12) that the designation data is not merely non-functional descriptive material. Appellants refer to the specification, though not to any particular portion, for the functions that the designation data permits as evidence that the designation data provides functional interrelationships with the operation of the system. Designation data is recited only in the method claims, not in system claims. Appellants have not shown how the type of data is functionally related to the claimed methods for selling. Therefore, we agree with the Examiner (Answer 7) that the particular type of data to be downloaded into the programmable devices is merely non-functional descriptive material.

Appellants contend (Br. 13 and 15) that the recitation in claim 3 of designation data being "representative of a physical location of a device in the system" is a positive limitation that cannot be dismissed as descriptive material. However, Appellants have not shown how the content of the data is functionally related to the method of selling the system. Therefore, the type, or content, of data downloaded is merely non-functional descriptive material. Accordingly, we will sustain the anticipation rejection of claims 1 through 11, 20, 22 through 25, 31 through 35, and 37 through 54.

ORDER

The decision of the Examiner rejecting claims 1 through 11, 20, 22 through 25, 31 through 35, and 37 through 54 under 35 U.S.C. § 102(e) is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a). *See* 37 CFR § 1.136(a)(1)(iv).

AFFIRMED

jlb

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